

### **REMARKS**

No amendments have been made to the claims. Accordingly, claims 1 and 3-8 are currently pending in the application, of which claim 1 is an independent claim. In view of the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

#### ***Change of Address***

Applicants note that the most recently issued Office Action was mailed to an incorrect address. Applicants further note that on March 26, 2004, a new assignment was recorded for the present application. In addition, a new power of attorney and change of address executed by the assignee was also filed on that date. A copy of these filings is provided herewith. Applicants request that the U.S. Patent and Trademark Office effectuate this change immediately in order to avoid any further delays in the prosecution of this patent application.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Publication No. 590055487 ("Nippon") in view of U.S. Patent No. 6,331,438 to Aylott *et al.* ("Aylott"). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1, among other things, recites that the "the light sensor is formed on said upper electrode of said light emitting element." Applicants respectfully submit that the prior art of record does not teach or suggest this feature.

As recognized by the Office Action, Nippon does not disclose a light sensor formed on a light emitting element, let alone a light sensor on the upper electrode of the light emitting element.

Further, Aylott fails to teach or suggest placing the light sensor on an electrode, let alone an upper electrode. As shown in Fig. 4 of Aylott, a photoluminescent sensor 37 is provided on transparent substrate 34. In operation, the specification states that “EL 35 is emitted from layer 31 through a transparent anode (not shown) and substrate 34 into a photoluminescent probe or sensor layer 37.” Col. 8, lines 60-63. Thus, the EL travels through first through the transparent anode, and then through the transparent substrate 34 prior to reaching the light sensor 37. Therefore, the light sensor cannot be formed or located on the electrode. Rather, it is formed on the substrate 34. For this reason, the combination of Nippon and Aylott fail to teach each and every element of the invention.

Further, there is no motivation for one of ordinary skill in the art to combine the teachings of Nippon and Aylott. The disclosure of Nippon is directed to an electroluminescent display element. The sensor in Nippon is capable of detecting the luminance of the light emitted from the element so as to change the drive voltage. In contrast, Aylott is directed to detecting biological, chemical and physical analytes. This is useful in such fields as medical, biochemical, analytical chemistry, occupational safety, microelectronic, environmental, military, and forensic applications. Col. 1, lines 22-25. A more descriptive listing of the uses, provided at column 3, line 26 to column 4, line 10, contains no description or suggestion of using the configuration in Aylott in electroluminescent display element. Rather, safety appears to be the primary aim of the device described in Aylott.

There is no reasoning provided in the Office Action why one of ordinary skill in the art would be motivated to combine the teachings from two such different fields. The Office Action has provided a cursory statement that the combination would be useful “because it aids in providing analysis of analytes in real time,” without providing any reasoning as to why analyzing analytes would be desirable in the context of a electroluminescent display element. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP §2143.01 (*citing In re Mills*, 916 F.2d 680). The prior art provides no objective motivation for this combination. Rather, the only teaching for this is found in Applicants’ invention. Clearly, this is improper hindsight. As the Office Action has failed to provide any objective motivation in the prior art for combining these references, the combination is improper and fails to establish a *prima facie* case of obviousness of claims 1 and 3.

For at least these reasons, none of Nippon and/or Aylott teach or suggest, either alone or in combination, having a sensor located on the upper electrode of a light emitting element. Therefore, Applicants respectfully submit that the claims are patentable over the prior art of record, and request that the rejection be withdrawn and the claims passed to issue.

### ***Dependent Claims***

Claim 4 stands rejected as unpatentable over Nippon in view of Mori and U.S. Patent No. 5,105,238 to Nikaido *et al.* (“Nikaido”). Claim 5-7 stand rejected as unpatentable over Nippon in view of Aylott, Nikaido and U.S. Patent No. 6,133,581 to Terao *et al.* (“Terao”). Claim 8 stands rejected as unpatentable over Nippon in view of Aylott, Nikaido, Terao and U.S. Patent No. 4,820,915 to Hamakawa *et al.* (“Hamakawa”).

Claims 4-8 depend from independent claim 1. None of Nikaido, Terao, and Hamakawa, either alone or in combination, remedy the deficiencies of Nippon, and Aylott as discussed above with respect to claim 1. Therefore, for at least the reasons set forth above with respect to claim 1, claims 4-8 are patentable over the prior art of record. Applicants respectfully request that the rejection be withdrawn and the claims passed to issue.


**CONCLUSION**

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



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